

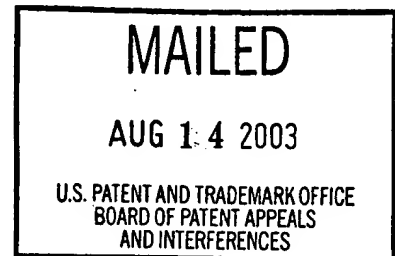
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ANHI SI LE

Appeal No. 2003-0893
Application No. 09/276,014

ON BRIEF



Before WINTERS, WILLIAM F. SMITH, and GRIMES, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1, 2, and 4 through 13, which are all of the claims remaining in the application.

Representative Claims

Claims 1, 9, and 13, which are illustrative of the subject matter on appeal, read as follows:

1. Hydrogenated starch hydrolysate, comprising
 - A. a content of hydrogenated monosaccharides, degree of polymerization equals 1, of from about 2.6 to about 7.7 wt.-%;

- B. a content of hydrogenated disaccharides, degree of polymerization equals 2, of less than or equal to 34.3 wt.-%;
- C. a content of hydrogenated trisaccharides, degree of polymerization equals 3, of less than 15 wt.-%;
- D. a content of hydrogenated oligosaccharides of hydrogenated quat- to decasaccharides, degree of polymerization equals 4 to 10, of less than 30 wt.-%; and
- E. a content of hydrogenated polysaccharides of greater than hydrogenated decasaccharides degree of polymerization is greater than or equal to 11, of about 14 to about 38 wt.-%.

9. Sugarless hard boiled candy comprising the hydrogenated starch hydrolysate according to claim 1.

13. Powder particles comprising malic acid or a mixture of acidulants encapsulated within a coating comprising the hydrogenated starch hydrolysate according to claim 1.

Prior Art References

The prior art references relied on by the examiner are:

Caboche	5,436,329	Jul. 25, 1995
Mentink et al. (Mentink)	5,314,701	May 24, 1994

The Rejections

The previously entered rejection of claim 13 under 35 U.S.C. § 102(b) has been withdrawn (Paper No. 19, page 2).

Claims 1, 2, and 4 through 12 stand rejected under 35 U.S.C. § 102(b) as described by Caboche.

Claims 1, 2, and 4 through 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mentink.

Deliberations

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) applicant's Appeal Brief (paper No. 18); (3) the Examiner's Answer (Paper No. 19); and (4) the above-cited prior art references.

On consideration of the record, including the above-listed materials, we reverse the rejection under 35 U.S.C. § 102(b). We vacate the rejection under 35 U.S.C. § 103(a) and remand this application to the examiner.

Applicant's Supplement to Appeal Brief

Initially, we shall address a question raised in applicant's "Supplement to Appeal Brief" (Paper No. 21). According to applicant, the PTO mailed a Notice of Allowance in related Application No. 09/702,210 containing claims "that are of equal or greater scope than claims 1, 2 and 4-11 that are on appeal in the present application" (Paper No. 21, page 1). Applicant argues that the PTO allowed claims 1 through 11 in Application No. 09/702,210, "which correspond closely to claims 1, 2 and 4-11 of the present application (in fact, allowed claim 1 of [Application No. 09/702,210] is slightly broader in

scope than claim 1 of the present application)" (Paper No. 21, page 2). Applicant further argues that the Caboche reference, U.S. Patent No. 5,436,329, is cited in the instant application and in Application No. 09/702,210. Applicant suggests that the PTO's actions, in mailing a Notice of Allowance in Application No. 09/702,210 and in maintaining the instant appeal, are irreconcilable.

We have carefully considered applicant's comments in the "Supplement to Appeal Brief." It appears, however, that the original Notice of Allowance in Application No. 09/702,210 was a mistake which has been superseded by a corrected Notice of Allowance mailed July 11, 2003. The corrected Notice of Allowance states that the allowed claims in Application No. 09/702,210 are claims 14 through 23. Further, on filing Application No. 09/702,210 as a divisional of Application No. 09/276,014 (the instant application), applicant instructed the PTO to cancel claims 1 through 13. See the preliminary amendment accompanying Application No. 09/702,210, filed October 31, 2000. On these facts, we find that the PTO's actions, in mailing a corrected Notice of Allowance in Application No. 09/702,210 and in maintaining the instant appeal, are not irreconcilable.

Section 102

We shall not belabor the record with extended discussion of the rejection under 35 U.S.C. § 102(b) based on Caboche. Rather, we find it sufficient to note that we are in substantial agreement with applicant's argument in the Appeal Brief, pages 4 through 6.

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). That is not the case here. The examiner does not and cannot point to any passage in Caboche which identically discloses or describes the hydrogenated starch hydrolysate or products comprising that hydrolysate recited in applicant's claims. The examiner does not point to any passage in Caboche identically describing the hydrogenated starch hydrolysate recited in applicant's claims including components A through E set forth in claim 1 and components (A)(i.) through (A) (v.) set forth in claim 12. In the Answer (Paper No. 19), page 6, the examiner refers to compositions disclosed by Caboche in column 12, Table I. However, the examiner has not established that either Composition A or Composition B, disclosed in Table I, fully meets each limitation of the hydrogenated starch hydrolysate recited in the appealed claims.

Where, as here, applicant's claimed subject matter is not identically described by the cited reference, the rejection under 35 U.S.C. § 102(b) cannot stand. In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972)(rejections under 35 U.S.C. § 102(b) proper only when claimed subject matter is identically disclosed or described in the prior art). Accordingly, the rejection of claims 1, 2, and 4 through 12 under 35 U.S.C. § 102(b) as described by Caboche is reversed.

Section 103

For the following reasons, we vacate the examiner's rejection of claims 1, 2, and 4 through 13 under 35 U.S.C. § 103(a) as unpatentable over Mentink and remand this application for further proceedings not inconsistent with the views expressed in this opinion.

In setting forth the rejection under 35 U.S.C. § 103(a), the examiner states that Mentink does not teach a hydrogenated starch hydrolysate comprising a content of hydrogenated disaccharides, degree of polymerization equals 2, of less than or equal to 34.3 wt.% as recited in independent claims 1 and 12. See the Examiner's Answer, Paper No. 19, page 4, last paragraph ("Mentink does not teach disaccharides at a composition of 34.3%"). The examiner argues, however, that Mentink discloses a minimum content of hydrogenated disaccharides of 35 wt.%; and that "one of skill in the art would not recognize a statistically significant difference between 34.3% and 35%" (id.). This is the argument responded to by applicant (Appeal Brief, Paper No. 18, page 9, last paragraph).

Considering now section (11) of the Examiner's Answer entitled "Response to Argument," we find the following analysis:

further review of Mentink shows that Mentink teaches that the lower limit of wt% for polymers with a DP [degree of polymerization] =2 is actually 30%, see column 6, lines 24 - 29, wherein Mentink teaches a preferred embodiment is to have more than 30% of molecules having a DP equal to 2. Thus the teachings of Mentink encompass polymers wherein the DP=2 at a wt% of less than the claimed 34.3 wt%. [Paper No. 19, page 8, last full paragraph]

Accordingly, there appears to be a disconnect between (1) the rationale supporting the examiner's statement of rejection under 35 U.S.C. § 103(a) in section (10) of the Answer; and (2) the discussion/analysis in section (11) entitled "Response to Argument." On these facts, it would appear that the reasoning set forth in the Examiner's Answer is internally inconsistent and that the rationale supporting the rejection under 35 U.S.C. § 103(a) requires clarification. For example, it is unclear whether the examiner adheres to the argument that Mentink discloses a minimum content of hydrogenated disaccharides of 35 wt.%. Likewise, it is unclear whether the examiner adheres to the rationale that "one of skill in the art would not recognize a statistically significant difference between 34.3% and 35%" (Paper No. 19, page 4, last paragraph).

On return of this application to the examining corps, we recommend that the examiner reevaluate the patentability of applicant's claims under 35 U.S.C. § 103(a) based on Mentink. If the examiner adheres to the view that any claim or claims are unpatentable over Mentink, he should clarify the rationale supporting the rejection; communicate that rationale to applicant; and provide applicant with an opportunity to respond.

Further respecting the rejection under 35 U.S.C. § 103(a), applicant has grouped and argued claim 13 separately in the Appeal Brief. See Paper No. 18, pages 4 and 10. The examiner responds that

Appellant's inclusion of an acidulant in claim 13 is not seen to be novel over the prior art as the use of acidulants such as malic acid, citric acid or tartaric acid in this food art is common practice. [Paper No. 19, page 4, 3rd paragraph]

The examiner also refers to acknowledged prior art discussed in applicant's specification (Paper No. 19, pages 8 through 10); but the rejection under 35 U.S.C. § 103(a) is over Mentink alone and the examiner does not include any "acknowledged prior art" in the statement of rejection.

On these facts, it would appear that the evidentiary basis and rationale supporting the rejection of claim 13 under 35 U.S.C. § 103(a) requires clarification. Although the examiner states that "use of acidulants such as malic acid, citric acid or tartaric acid in this food art is common practice," nevertheless, our reviewing court has cautioned that "common knowledge and common sense" are not a substitute for evidence and that determination of patentability must be based on evidence. In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

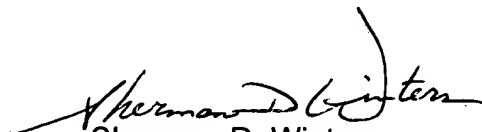
On return of this application to the examining corps, we recommend that the examiner reevaluate the patentability of claim 13 under 35 U.S.C. § 103(a). If the examiner believes that claim 13 is unpatentable based on the combined disclosures of Mentink and acknowledged prior art discussed in applicant's specification, we recommend that the examiner fashion a statement of rejection including both Mentink and the acknowledged prior art; communicate that rejection to applicant in an appropriate Office action; and provide applicant with an opportunity to respond. To the extent that the examiner would shore up any rejection of claim 13 with reliance on

"common knowledge" or "common sense" or "common practice" in the art, we emphasize our reviewing court's admonition that such reliance does not provide an adequate evidentiary basis to support a rejection under 35 U.S.C. § 103(a) (id.).

Accordingly, the rejection of claims 1, 2, and 4 through 13 under 35 U.S.C. § 103(a) as unpatentable over Mentink is vacated, and this application is remanded¹ for further proceedings not inconsistent with the views expressed in this opinion.

We are not authorizing a supplemental answer under 37 CFR § 1.193(b)(1).

REVERSED-IN-PART; VACATED-IN-PART; and REMANDED


Sherman D. Winters
Administrative Patent Judge


William F. Smith
Administrative Patent Judge


Eric Grimes
Administrative Patent Judge

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¹ The term "vacate," as applied to an action taken by an appellate tribunal, means to set aside or to void. When the Board vacates an examiner's rejection, the rejection is set aside and no longer exists. Ex parte Zambrano, 58 USPQ2d 1312, 1313 (Bd. Pat. App. & Int. 2001).

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